REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1, 2, 4-16 and 45-54; the only claims pending and currently under examination in this application.

Claims 1, 2, 10, 47 and 48 have been amended. Support for these amendments is found throughout the specification and claims as originally filed, for example at the following exemplary locations: pg. 16, lines 28-31; pg. 17, lines 19-28; pg. 17, line 29 to pg. 18, line 1; and Claims 6 and 13. As such, no new matter is added, and the Applicants respectfully request entry of the currently presented amendments.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, 4-16, and 47-54 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zeleny et al. (U.S. Patent No. 6,215,894), in view of Ellison et al. (U.S. Patent Application Publication No. 2002/0086319).

In order to meet its burden in establishing a rejection under 35 U.S.C. §103, the Office must first demonstrate that a prior art reference, or references when combined, teach or suggest all claim elements. *See e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007); *Pharmastem Therapeutics v. Viacell et al.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007); MPEP § 2143(A)(1). In addition to demonstrating that all the elements were known in the prior art, the Office must also articulate a reason for combining the elements. *See e.g., KSR*, 127 S.Ct. at 1741; *Omegaflex, Inc. v. Parker-Hannifin Corp.*, 243 Fed. Appx. 592, 595-596 (Fed. Cir. 2007) (citing *KSR*). Further, the Supreme Court in *KSR* also stated that that "a court *must* ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR*, 127 S.Ct. at 1740 (emphasis added). As such, in addition to showing that all elements of a claim were known in the prior art and that one of skill had a reason to combine them, the Office must also provide evidence that the combination would be a predicted success.

In making this rejection, the Examiner alleges that Zeleny substantially teaches the Applicants' claimed invention. Office Action, pg. 3, section 4, ¶ 2 (citing Zeleny, col. 2, lines 29-44; col. 3; and FIGS. 3-4). However, the Examiner concedes that, "Zeleny et al do not specifically teach shipping the fabricated array and

forwarding the array related data to a remote location." Office Action, pg. 3, section 4, ¶ 3. To remedy the deficiencies of Zeleny, the Examiner attempts to rely on Ellison's alleged disclosure of "shipping the array and forwarding the array related data to a remote location i.e. to shipping address contained in the machine readable information". Office Action, pg. 4, lines 2-4 (citing Ellison, ¶ 8).

The Applicants respectfully disagree. As indicated above, the claims have been amended to clarify that the array is shipped and an identifier associated with the array related data is forwarded to a user location remote from a central fabrication station. In addition, at the user location, the method includes the steps of: (i) retrieving the array related data associated with the identifier from the memory at the central fabrication station; and (ii) communicating the retrieved array related data to the user location remote from the central fabrication station.

Nowhere does Zeleny disclose or suggest such elements. In contrast, Zeleny discloses that, "Preferably, however, the system is programmed to retrieve the information from the biochip. The protocols are therefore identified, or even described, in the machine-readable code on the biochip." Zeleny, col. 2, lines 29-33.

Therefore, Zeleny fails to disclose or suggest the elements of: (i) retrieving the array related data associated with the identifier from the memory at the central fabrication station; and (ii) communicating the retrieved array related data to the user location remote from the central fabrication station, as claimed by the Applicants.

Ellison was cited solely for its alleged disclosure of shipping the array and forwarding the array related data to a remote location. However, nowhere does Ellison disclose or suggest the elements of: (i) retrieving the array related data associated with the identifier from the memory at the central fabrication station; and (ii) communicating the retrieved array related data to the user location remote from the central fabrication station, as claimed by the Applicants. At best, Ellison merely discloses that, "The substrate also contains machine-readable information relating to the molecular moieties, wherein the information is contained in a discrete region of the substrate that is non-coplanar with respect to the substrate surface having the molecular moieties attached thereto. Preferable, the information is machine-readable and located on a surface that opposed the surface to which the molecular moieties are attached." Ellison, pg. 6, ¶ [0066]. As such, Ellison fails to remedy the deficiencies in Zeleny discussed above.

Consequently, the Applicants contend that a *prima facie* case of obviousness can not be maintained because the cited references do not disclose or suggest all the elements of the Applicants' claimed invention. As such, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1, 2, 4-16, and 47-54 be withdrawn.

Claims 1, 2, 4-16, and 47-54 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Perttunen et al. (U.S. Patent No. 5,968,728) in view of Ellison et al. (U.S. Patent Application Publication No. 2002/0086319).

In maintaining the instant rejection, the Examiner alleges that Perttunen substantially discloses the Applicants' claimed invention. However, the Examiner concedes that Perttunen does not teach shipping the fabricated array and forwarding the array related data to a remote location. Office Action, pg. 7, lines 4-6. Thus, to remedy the deficiencies of Perttunen, the Examiner attempts to rely upon the teachings of Ellison.

The Applicants respectfully disagree and contend that the cited references fail to disclose the claimed elements that the array is shipped and an identifier associated with the array related data is forwarded to a user location remote from a central fabrication station. In addition, the cited references fail to disclose or suggest the claimed elements of: automatically selecting one or more machine readable algorithms for how to read an array or machine readable algorithms for how to process data from an array following reading of the array based on said retrieved array related data; and reading the array according to an algorithm of the one or more automatically selected machine readable algorithms to obtain data.

Perttunen discloses as follows:

> Embodiments of the present invention provide a molecular detection device having an arrangement of molecular receptors which is concealed or obscured. As a result, molecular structures in a sample applied to the molecular detection device are obscured or concealed with knowledge of hybridization information alone. To deduce the molecular structures in the sample, the hybridization information is processed in conjunction with data indicating the arrangement of the molecular receptors. The data can be stored in a member retained by an end user to restrict the ability of others to deduce the molecular structures in the sample. Alternatively, the data can be stored in a database that provides limited access thereto.

Perttunen, col. 2, lines 34-47. Thus, Perttunen actually discloses that data is "retained by an end user to restrict the ability of others to deduce the molecular structures in the sample." Perttunen, col. 2, lines 34-47. Therefore, Perttunen does not disclose or suggest the element of "automatically selecting one or more machine readable algorithms for how to read an array or machine readable algorithms for how to process data from an array following reading of the array based on said retrieved array related data", as claimed by the Applicants.

Additionally, the Examiner maintains that Perttunen teaches "that the user, at a user location retrieves array related data (e.g. mapping) and selects machine readable algorithms (e.g. instructions) (Column 3, lines 45-67 and Fig. 2) for reading data and processing the data read by the user (Column 5, lines 7-20 and Column 7, line 40–Column 8, line 67)." Office Action, pg. 15, section 7, ¶ 1.

The Applicants respectfully disagree and contend that the cited references fail to disclose the claimed element of "reading said array according to an algorithm of said one or more automatically selected machine readable algorithms to obtain data". Perttunen discloses as follows:

> Advantageously, one or more molecular structures in the sample are unidentifiable based on the hybridization results alone, i.e. without knowledge of the mapping. By retaining the second portion 130 having the data 132 indicative of the mapping, the end user restricts the ability of others to deduce molecular structures in the sample based on the hybridization results.

Perttunen, col. 8, lines 48-54. Moreover, Perttunen actually discloses that, "The end user allows an individual to deduce information based on binding results by providing the member [i.e., second portion **130**] to the individual. The end user inhibits an individual to deduce the information by withholding the member [i.e., second portion **130**] from the individual." Perttunen, col. 9, line 65 to col. 10, line 2. Consequently, Perttunen does not disclose or suggest the element of "reading said array according to an algorithm of said one or more automatically selected machine readable algorithms to obtain data", as claimed by the Applicants.

As Ellison was cited solely for its alleged disclosure of a method including shipping the array and forwarding the array related data to a remote location, Ellison fails to remedy the deficiencies of Perttunen discussed above.

Therefore, for the reasons stated above, a *prima facie* case of obviousness has not been established because the cited combination of Perttunen and Ellison fails to teach or suggest every element of the rejected claims. Accordingly, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1, 2, 4-16, and 47-54 be withdrawn.

Claims 45-46 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Perttunen et al. (U.S. Patent No. 5,968,728) in view of Ellison et al. (U.S. Patent Application Publication No. 2002/0086319 A1) and further in view of Zelany et al. (U.S. Patent No. 6,215,894). As set forth above, Perttunen is deficient in that it fails to disclose or suggest the claimed elements of "automatically selecting one or more machine readable algorithms for how to read an array or machine readable algorithms for how to process data from an array following reading of the array based on said retrieved array related data", and "reading said array according to an algorithm of said one or more automatically selected machine readable algorithms to obtain data". Ellison was cited solely for its alleged disclosure of a method including shipping the array and forwarding the array related data to a remote location. Zelany was cited solely for its alleged disclosure of the use of control probes. Consequently, both Ellison and Zeleny fail to remedy the deficiencies of Perttunen discussed above. Therefore, the cited combination of references does not disclose or suggest all the elements of Claims 45-46, and the Applicants respectfully request withdrawal of this rejection.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone James Keddie at (650) 327-3400.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

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